IN THE

Supreme Court of the United States

OCTOBER TERM, 1951.

No. 713.

LAWRENCE B. SCOTT,
Petitioner,

vs.

HAL W. HARMAN,
Respondent.

OPPOSING BRIEF TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT.

REASON FOR THIS BRIEF.

This brief is filed on behalf of respondent, Hal W. Harman, for the protection of the interest of respondent's former counsel, Warren H. F. Schmieding, and is in ac-

cordance with a directive of the Honorable Judge R. Nevin, chief judge, as set forth in the transcript of further proceedings, held in the afternoon session of Wednesday, August 23, 1950 (R., 478). The agreement between Hal W. Harman, respondent and his former counsel, is set forth on page 506. The trial court stated: "* * * I think Mr. Schmieding should remain as counsel of record and that he should be protected in so far as his interests are concerned in this case." (R., 484.) "* * * I am interested in seeing that Mr. Schmieding, as an officer of this court, is protected to the extent he has a contract with a client that was made at the time." (R., 486.)

PETITION FOR WRIT OF CERTIORARI SHOULD BE DENIED.

The reasons set forth in the writ of certiorari do not fall within the character of any of the sub-sections (a), (b) or (c) of paragraph 5 of Rule 38, because

(1) The decision of the Court of Appeals, affirming the District Court is in direct accord with the applicable decisions of this Supreme Court, in that this court has always found that a combination of elements that create, for the first time, a long sought result, is a patentable combination.

(2) While it is true that the decisions of the courts below effect a large portion of the casting repair industry, it will not result in extensive litigation in other circuits, since on information and belief, the users of devices similar to those of petitioner and respondent are licensees of the patent in suit and petitioner is enjoined from infringement.

ANSWER TO PETITIONER'S QUESTIONS PRESENTED.

The "Questions presented by petitioner" do not present the full facts, are misleading, are erroneous and do not speak the whole truth.

Since the claims define the invention, question 1 omits, obviously purposely, one of the salient features of the claimed invention, which feature in combination with the other elements defined in the claims, produces a new result. Question 1 fails to state that the bulged portions of the insert (or the metal body defined in the claims), is expansible by pressure; that the insert conforms substantially in size and shape to the drilled holes or recess in the cracked casting; and that the expansible bulged portion is compressed (claim 1) or expanded (claim 2) in the drilled holes after being inserted therein.

The statement in question 2, to the effect that the invention in the instant case "was no higher than that of the invention involved in the A. & P. case", is merely argument and has no basis whatsoever.

The District Court, after hearing all of the evidence, arguments and briefs by the parties, stated (R., 461)

> "The court is of the opinion and so finds that the claims here in issue are each and both valid in law, and as no one prior to the plaintiff patentee had conceived of a combination which would give the patentee's result, that the patent in suit, if not indeed a basic one, at least is one of high rank."

From finding of facts 8, 9 and 10 (R., 467), it is apparent that the instant invention is not one in which "two and two have been added together and still they make only four", A. & P. case (supra), but in which a long sought and never

before obtained result was accomplished. Like, as stated in the A. & P. case "* * * only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable."

Obviously, from the finding of facts 8, 9 and 10, the invention, herein under consideration is of high order, and such invention relates to subject matter of far greater importance than that of the A. & P. case. Also it is obvious, from said finding of facts, that petitioner's question 1 was not fully presented.

Petitioner's question 3 has no basis, whatsoever, under the facts of the instant case, since patentee is not claiming a combination of a device and a material upon which the device works.

STATEMENT.

(To Correct Inaccuracies and Omissions of Petitioner's Statement.)

Petitioner's statement endeavors to mislead your Honors into believing that its insert or fastening element is "a substantially square bar". The material originally may have been a substantially square bar, but it is apparent from Fig. 9 of R. 406 that the bar is deformed by toothed rollers 11 and 12 to form a fastener comprising bulged portions A and restricted portions B, more clearly shown in Fig. 1. These bulged and restricted portions are the same as the "bulged or enlarged portions 13, 14 and 15 and the restricted or neck portions 16 (R., 398) of the patent in suit. Petitioner's recess, for receiving the fastener, is shown at 17 in Fig. 5, (R., 406), and the crack across the casting is shown at C'. The bulged portions A and restricted portions B, of petitioners's fastener (R., 406) com-

plements the recess into which it is placed, in the same manner as the bulged and restricted portions, of the fastener of the patent in suit (R., 398), complement the recess 22 or 23 (Fig. 1).

Paragraph 2 of petitioner's statement (page 4) setting forth that the prior art meets all of the elements of claims 1 and 2, is inaccurate since the prior art does not even suggest compressing and expanding an expansible fastener or insert.

The last paragraph (page 4) of petitioner's statement is merely argument and has no basis in law or fact. The fastener which is provided with bulged and restricted portions, and which is expansible by pressure and which is inserted and compressed or expanded in a recess opening, having substantially the same size and shape as the fastener, is as important in the combination as an ankle between the leg bone and the foot.

REGARDING PETITIONER'S BRIEF.

The statement in petitioner's brief, in support of writ of certiorari, is also inaccurate, misleading and it purposely omits certain facts.

We have already pointed out that petitioner's infringing structure does not include a substantially square bar, as alleged by petitioner; and his statement purposely omits the fact that the infringing structure includes a fastener which is provided with bulged and restricted portions and which correspond to the design in the recess; the statement also omits the fact that his fastener is expansible by pressure and is compressed or expanded in the design recess.

SUMMARY OF ARGUMENT.

1. Harman patent in suit involves invention over the prior art.

2. Claims 1 and 2 of the Harman patent are not invalid because they do not merely show a combination of a device and the material upon which the device works, as alleged by petitioner. To the contrary, the fastener of the present invention is a permanent and vital element in a patentable combination and after such combination is formed, the fastener is never changed or severed therefrom. Such fastener continues to cooperate with the other elements of the combination to produce a new and useful result, which has long been sought and never attained prior to the disclosure of the instant invention.

ARGUMENT.

The trial court, after considering all of the facts and the prior art (see finding of facts 15 to 23, R., 468), stated (R., 470):

> "24. None of the patents referred to in findings Nos. 15 to 21, inclusive, anticipate or specifically restrict claims 1 and 2 of the patent in suit, nor do any of the other patents plead as anticipation by defendant in his answer."

and also stated:

> "27. Plaintiff was the original and first inventor of the invention of the patent in suit, as defined by claims 1 and 2 here in issue. Claims 1 and 2 are directed to a new combination of elements which produce a new and useful result and is not present or suggested in any of the prior art relied upon by defendant."

Although, as set forth in petitioner's brief (page 8), "various other methods of repairing cracks were known prior to Harman", petitioner followed the steps taught to him by respondent, which steps are the product of the instant patent.

The Harman patent in suit has not merely brought together segments of prior art and then claimed them in congregation as a monopoly, as alleged by petitioner, but has rearranged the elements, as set forth in findings of fact 8, 9 and 10 (R., 467) to produce a new and useful result, and, as stated in finding of fact 11 (R., 468):

> "It is more than and beyond the ordinary and expected mechanical or engineering skill of persons skilled in the art to which the invention relates".

The invention defined in the patent in suit is far more important, and the results flowing therefrom were far more

sought after, than the invention which your Honors held as patentable in the case of Goodyear Tire & Rubber Co., Inc., et al. v. Ray-O-Vac Co., 321 U. S., 275. Your Honors will recall that the question there involved was whether invention was present in encasing the well known flashlight battery cell in a well known metallic shell. From the decision of the trial court in Ray-O-Vac Co. v. Goodyear Tire & Rubber Co., Inc., et al., 45 Fed. Supp., 927, it will be seen that all the elements of the combination claimed in a patent under consideration, were old in the same art including the metallic casing for the dry cell. All that the patentee did in that case was to crimp the upper and lower edges of the cylindrical sheet against the top and bottom of the conventional flashlight dry cell so as to prevent leakage of electrolite from the dry cell. Crimping to prevent leakage obviously was old. The trial court in that case cited your Honors' decisions in Carnegie Steel v. Cambria Iron Company, 185 U. S., 403; Looms Co. v. Higgins, 105 U. S., 580; Diamond Rubber Company v. Consolidated Tire Company, 220 U. S., 428. In the Ray-O-Vac case your Honors stated:

> "Viewed after the events, the means Anthony adopted seems simple and such as should have been obvious to those who worked in the field, but this is not enough to negative invention."

This is particularly true when a patentee answers a long sought after result.

In each of the decisions cited by the petitioner, the separate elements of each of the apparatus involved functioned as they always had functioned in the same combination. For example in the case of Toledo Pressed Steel Co. v. Standard Parts, Inc., cited by petitioner, the alleged invention was directed to a torch for burning liquid fuel. A wick

receiving tube extended into the container for the fuel and was provided with a particular form of cap which prevented the extinguishment of the flare in all kinds of weather. The prior art showed that this same cap was used in the same combination in street lamp-lighter's torches. Your Honors there stated:

> "As before, the torch continued to produce a luminescent, undulating flame, and the cap continued to let in air for combustion, to protect the flame from wind and rain and to allow it to emerge as a warning signal. They performed no joint function. Each served as separately, it had done."

In the case of Cuno Engineering Corp. v. Automatic Devices Corp., the patentee applied a well known automatic control to a cordless electric heater coil. The result accomplished by these elements was old.

In practicing the present invention, the fastenings 12 are hammer-drawn cold in the recess. As stated in the patent in suit (R., 400, P-2, L-55, col. 1):

> "By installing the locking fastenings 12 in their laminations, each fastening is completely cold drawn to the limit, and the highest possible tensile strength is obtained; and due to the surface increase by use of the laminations, a still greater strength is obtained. Thus it is obvious that a joint can be made according to the present invention that will possess greater strength than the iron as the tensile strength of cast iron is much lower than the annealed alloys."

Thus the locking fasteners are as much a part of the combination as the casting or gears and levers, etc., are parts of other patentable combinations, and such fasteners are as much an integral part of a resultant structure as is the ankle with the leg bones and the foot bones. Therefore petitioner's statement that "One cannot have a patent for a combination of a device and the materials upon which the

device works" is in no way applicable to the present set of facts and the decisions cited have no relevancy whatsoever. The locking fasteners are as much a part of the combination of elements as the tubular steel sheath was in the Ray-O-Vac v. Goodyear (supra) case. Your Honors, in that case, held claim 3 invalid which read as follows:

> "3. A device as specified in claim 1 in which the marginal end portions of the metal sheath are turned inwardly to form flanges which overlap the end closures."

In each of the cases cited by the petitioner, except the "Dry Ice" case (Carbice Corporation of America v. American Patents Development Corporation) the claimed structure included a product which moved through the machine such as an envelope or leaf of tobacco. Your Honors did not hold that the patent in the "Dry Ice" case was invalid. Your Honors merely held that the defendant was not guilty of contributory infringement. In the instant case, the combination is complete in itself as defined in the claims and does not require the use of a passive element to complete its operative function.

CONCLUSION.

Wherefore, it is respectfully submitted that the petition for writ of certiorari should be denied.

Respectfully submitted,

WARREN H. F. SCHMIEDING,

For the Protection of the Interests of Respondent's Former Counsel.